

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                       |   |
|-----------------------|---|
| In re Application of: | Jonathan Stinson  |
| Application No.:      | 10/037036   |
| Filed:                | October 25, 2001  |
| For:                  | Balloon Expandable Polymer Stent With Reduced<br>Elastic Recoil |
| Examiner:             | Vi X Nguyen   |
| Group Art Unit:       | 3734  |

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Docket No.: S63.2B-9919-US01

**Application for Patent Term Adjustment, 37 CFR 1.705**

The applicant hereby requests reconsideration of the patent term adjustment determination made by the Director and reported in the Determination of Patent Term Adjustment under 35 USC 154 (b), dated 10/03/2008, copy attached.

The Determination of Patent Term Adjustment, mailed 10/03/2008, states the adjustment to date as 740 days. Also attached is the PAIR record showing the basis for this determination. The determination is incorrect.

The application was filed after May 28, 2000 and so is entitled to the benefit of the current version of 35 U.S.C. 154. The determination fails to follow the calculation method required by law as determined in *Wyeth v. Dudas*, 88 USPQ2d 1538 (DC DC 2008), which is controlling law for the issues presented herein.

This Application also constitutes a request that a **Final Determination** be made in accordance with the determination method described herein.

- (1) This request is accompanied by the fee set forth in §37 CFR 1.18(e).
- (2) Statement of the facts involved:

(i) The correct patent term adjustment and the basis under 37 CFR § 1.702 for the adjustment is as follows:

As of 10/03/2008\*:

|                      |             |
|----------------------|-------------|
| USPTO delay days     | 773         |
| Applicant delay days | -33         |
| Non-overlapping      |             |
| Three year days      | <u>1170</u> |
| Correct Adjustment   | <u>1910</u> |

\* The three year calculation continues until the issue date. Therefore, when the issue date has been determined a **Final Determination** should be made accounting for the additional number of days in the interval after 10/3/2008 until the issue date.

(ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled are explained as follows:

The Office calculation of 740 days fails to recognize any "three years" delay days. As *Wyeth* establishes, this is improper. This application was pending for more than three years as of 10/26/2004, and no time was consumed by continued examination of the application under 35 U.S.C. 132(b); no time was consumed by an interference proceeding under 35 U.S.C. 135(a); no time was consumed by the imposition of a secrecy order under 35 U.S.C. 181; by review by the Board of Patent Appeals and Interferences or a Federal court. All delay in the processing of the application by the Office that was requested by the applicant has already been accounted for.

From and including 10/26/2004 through 10/03/2008, the date of allowance, the number of three years days was 1439 days. There are no applicant delays in this interval. Subtracting the overlap of 269 days (260+109) of USPTO delay falling in this same interval, for which the patent term has already been credited, leaves a balance of 1170 days, which balance should have been added to the 740 days calculated for the adjustment as of the date of the Determination. Thus the total adjustment that should have been shown on the 10/13/2008 Determination of Patent Term Adjustment under 35 USC 154 (b) was 1910 days.

(iii) The patent is not subject to a terminal disclaimer.

(iv) (A) The applicant does not believe that there are any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704, other than those already accounted for in the applicant delay days noted above.

All items required under 37 CFR 1.705 having been provided herein, the applicant requests that the Determination of Patent Term Adjustment, mailed 10/03/2008, be corrected to show an adjustment of 1910 days and that a Final Determination be made on the basis of the interval from 10/3/2008 until the issue date.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: December 22, 2008

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## UNITED STATES PATENT AND TRADEMARK OFFICE

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|  |            |                      |                     |                  |
|--|------------|----------------------|---------------------|------------------|
| APPLICATION NO.  | FILED DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/637,036   | 10/25/2001 | Jonathan S. Stinson  | SG32-9919 US01      | 5380             |
| 4991   | 7670       | 10/03/2008           | EXAMINER            |                  |
| VIDAS, ARRETT & STEINKRAUS, P.A.<br>SUITE 400, 6640 SHADY OAK ROAD<br>EDEN PRAIRIE, MN 55344 |            |                      | NORTHRUM, VI X      |                  |
|  |            |                      | ART UNIT            | PAPER NUMBER     |
| 3734   |            |                      |                     |                  |
| DATE MAILED: 10/03/2008  |            |                      |                     |                  |

**Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)**  
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 740 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 740 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

10/037,036

## BALLOON EXPANDABLE POLYMER STENT WITH REDUCED ELASTIC RECOIL

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| Select New Case | Application Data | Transaction History | Image File Wrapper | Patent Term Adjustments | Continuity Data | Published Documents | Address & Attorney/Agent |
|-----------------|------------------|---------------------|--------------------|-------------------------|-----------------|---------------------|--------------------------|
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**Patent Term Adjustment**

|                              |            |                                      |     |
|------------------------------|------------|--------------------------------------|-----|
| Filing or 371(c) Date:       | 10-25-2001 | USPTO Delay (PTO) Delay (days):      | 773 |
| Issue Date of Patent:        | -          | Three Years:                         | -   |
| Pre-Issue Petitions (days):  | +0         | Applicant Delay (APPL) Delay (days): | 33  |
| Post-Issue Petitions (days): | +0         | Total Patent Term Adjustment (days): | 740 |
| USPTO Adjustment (days):     | +0         | <u>Explanation Of Calculations</u>   |     |

**Patent Term Adjustment History**

| Date       | Contents Description                            | PTO(Days) | APPL(Days) |
|------------|---|-----------|------------|
| 10-03-2008 | Mail Notice of Allowance                        |           |            |
| 10-01-2008 | Document Verification                           |           |            |
| 10-01-2008 | Notice of Allowance Data Verification Completed |           |            |
| 09-22-2008 | Date Forwarded to Examiner                      |           |            |
| 09-16-2008 | Appeal Brief Filed                              |           |            |
| 09-16-2008 | Notice of Appeal Filed                          |           |            |
| 06-30-2008 | Mail Non-Final Rejection                        | 109       |            |
| 06-23-2008 | Non-Final Rejection                             |           |            |
| 12-08-2007 | Appeal Brief Review Complete                    |           |            |
| 12-08-2007 | Date Forwarded to Examiner                      |           |            |
| 11-13-2007 | Appeal Brief Filed                              |           |            |
| 09-12-2007 | Notice of Appeal Filed                          |           |            |
| 07-13-2007 | Mail Final Rejection (PTOL - 326)               |           |            |
| 07-05-2007 | Final Rejection                                 |           |            |
| 05-03-2007 | Date Forwarded to Examiner                      |           |            |
| 04-23-2007 | Response after Non-Final Action                 |           |            |
| 02-05-2007 | Mail Non-Final Rejection                        |           |            |
| 02-04-2007 | Non-Final Rejection                             |           |            |
| 11-25-2006 | Date Forwarded to Examiner                      |           |            |
| 11-15-2006 | Amendment after Final Rejection                 |           |            |
| 10-11-2006 | Mail Final Rejection (PTOL - 326)               |           |            |
| 10-02-2006 | Final Rejection                                 |           |            |
| 08-03-2006 | Date Forwarded to Examiner                      |           |            |
| 08-01-2006 | Response after Non-Final Action                 |           |            |
| 07-05-2006 | Mail Non-Final Rejection                        |           |            |

|            |  |     |
|------------|--|-----|
| 06-27-2006 | Non-Final Rejection                          |     |
| 04-17-2006 | Case Docketed to Examiner in GAU             |     |
| 03-21-2006 | Date Forwarded to Examiner                   |     |
| 03-17-2006 | Response to Election / Restriction Filed     |     |
| 03-03-2006 | Mail Restriction Requirement                 | 260 |
| 03-01-2006 | Requirement for Restriction / Election       | ↑   |
| 12-27-2005 | Date Forwarded to Examiner                   | ↑   |
| 02-16-2005 | Appeal Brief Filed                           | ↑   |
| 11-29-2005 | Miscellaneous Incoming Letter                |     |
| 12-08-2004 | Letter Requesting Interview with Examiner    |     |
| 12-20-2004 | Notice of Appeal Filed                       |     |
| 11-11-2004 | Miscellaneous Incoming Letter                |     |
| 10-05-2004 | Mail Final Rejection (PTOL - 326)            | 4   |
| 10-04-2004 | Final Rejection                              | ↓   |
| 07-21-2004 | IFW TSS Processing by Tech Center Complete   | ↓   |
| 05-15-2003 | Reference capture on IDS                     | ↓   |
| 06-24-2002 | Reference capture on IDS                     | ↓   |
| 02-27-2002 | Reference capture on IDS                     | ↓   |
| 07-21-2004 | Date Forwarded to Examiner                   | ↓   |
| 06-01-2004 | Response after Non-Final Action              | 33  |
| 06-01-2004 | Request for Extension of Time - Granted      | ↑   |
| 06-01-2004 | Workflow incoming petition IFW               | ↑   |
| 06-01-2004 | Workflow incoming amendment IFW              | ↑   |
| 01-29-2004 | Mail Non-Final Rejection                     | 400 |
| 01-28-2004 | Non-Final Rejection                          | ↓   |
| 12-04-2003 | Case Docketed to Examiner in GAU             | ↓   |
| 05-15-2003 | Information Disclosure Statement (IDS) Filed | ↓   |
| 05-15-2003 | Information Disclosure Statement (IDS) Filed | ↓   |
| 12-16-2002 | Case Docketed to Examiner in GAU             | ↓   |
| 06-24-2002 | Information Disclosure Statement (IDS) Filed | ↓   |
| 06-24-2002 | Information Disclosure Statement (IDS) Filed | ↓   |
| 02-27-2002 | Information Disclosure Statement (IDS) Filed | ↓   |
| 02-27-2002 | Information Disclosure Statement (IDS) Filed | ↓   |
| 03-16-2002 | Case Docketed to Examiner in GAU             | ↓   |
| 02-01-2002 | Application Dispatched from OIPE             | ↓   |
| 01-31-2002 | Application Is Now Complete                  | ↓   |
| 01-16-2002 | IFW Scan & PACR Auto Security Review         | ↓   |
| 10-25-2001 | Initial Exam Team nn                         | ↓   |